UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,001	12/10/2001	Ynjiun P. Wang	T075A	3855

7590 02/24/2003

Daniel R. McGlynn
Telxon Corporation
One Symbol Plaza MS: A-6
Holtsville, NY 11742-1300

EXAMINER
JEANTY, ROMAIN

ART UNIT	PAPER NUMBER
3623	

DATE MAILED: 02/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/016,001	WANG ET AL.	
	Examin r	Art Unit	
	Romain Jeanty	3623	

-- The MAILING DATE of this communication app ars on the cov r she t with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 November 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) *5-15* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

1. This communication is in response to the amendment filed on Novenber 25, 2002. Applicant elected with traverse Group I (claims 1-4). Claims1-4 are pending in the application.

Response to Arguments

2. Applicant's arguments filed 11/25/2002 with regard to claims 1-4 have been fully considered but they are not persuasive.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hudetz et al (U.S. Patent No. 5,978,773) in view of Powell (U.S. Patent No. 5,887,271).

As to claims 1 and 3, Hudetz discloses:

Providing the customer with a bar code symbol reader (Col. 5, lines 1-5).

Scanning a uniform product code (UPC) bar code symbol (col. 8, lines 38-43); and

Providing an associated table in a database between the UPC symbol data and an Internet web site address affiliated with the product manufacturer (Col. 7, lines 17-28 and Col. 7, lines 64 through Col. 8, line 10);

Providing the associated web site address to a remote computing device of the consumer for allowing the consumer to make a product information inquiry to said web site address (e.g., displaying a web page having a URL for the user to click on to make a product inquiry)(Col. 7, lines 45-57). Hudetz does not explicitly disclose providing demographic information about the consumer to the product manufacturer by utilizing the information inquiry. Powell on the other hand, discloses a system for locating products which upon completing a transaction in which one more incentives is received and a redemption data which includes customer ID data which infers that this demographic data has been provided to the manufacturer (col. 7, lines 1-7). It would have been obvious to a person of ordinary skill in the art to modify the Hudetz's system to include providing the demographic information to a manufacturer as evidenced by Powell. The motivation being to facilitate the manufacturer to optimize his marketing program through utilization of more accurate targeting.

As per claim 2, Hudetz et al discloses the bar code reader being provided at the user's terminal (see figure 1).

5. Claims 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hudetz et al and Powell as applied to claim 1 above, and further in view of Kaplan (U.S. Patent No. 5,963,916).

As per claim 4, as proper and understood by the examiner, Hudetz et al and Powell does not explicitly disclose providing targeted e-mails to the consumer for product announcements by the manufacturer. Kaplan on the other hand, discloses sending a product notification to a user. Note column 16, lines 16-26. It would have been obvious to a person of ordinary skill in the art to modify Hudetz et al and Powell by including an e-mail notification as taught by Kaplan. The

motivation being to encourage a user to purchase certain desired products from the manufacturer thereby increasing marketing sales for the manufacturer.

Remarks

6. Applicant asserted that the combination of Hudetz et al and Powell does not make obvious the subject invention as recited in claims 1-3. Applicant further supported his assertion by arguing that the combination of Hudetz et al and Powell does not teach or suggest providing demographic information about a customer to a product manufacturer by utilizing the information inquiry. In particular, applicant argued hat Powell does not utilize a product information inquiry made to the product manufacturer to provide demographic information about the consumer

In response, examiner disagrees with applicant's position because Powell clearly teaches a customer completing an application containing questions to collect demographic data about the customer. The customer's demographic information is stored and retrieved when the user requests product information. The customer demographic data is sent to a manufacturer when the customer uses the card to request product information. Note col. 6, line 49 through col. 7, line 14.

In regard to Applicant's argument that:

> .....A prima facie case of obviousness is established by showing of three basic criteria. First, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) when combined) must teach or suggest all the claim limitations. See MPEP § 706.02(j). The teaching or suggestion make the claimed

> combination and the reasonable expectation of success must be found in the prior art and not based on applicant's disclosure. See In re Vacek, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Emphasis added.

In response, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969. In this case, the Powell reference would facilitate the manufacturer to optimize his marketing program through utilization of more accurate targeting.

Applicant further argued that that Powell product inquiry id s not directed toward the product manufacturer and does not employ the Internet, and therefore, can not be used to deirectly by the product manufacturer to obtain demographic information regarding the inquiring consumer. In response, the examiner disagrees with applicant's position because Powell does teach the use of a consumer computer network, modem, etc. Therefore, Powell does employ the Internet to obtain the demographic information regarding the inquiring consumer (i.e. when the consumer uses the issued card to request a manufacturer's product information). Note col. 4, lines 21-37 and col. 6 line 49 through col. 7 line 14.

Applicant further asserted that Kaplan does not make up for the aforementioned deficiencies of Hudetz et al and Powell with respect to claim 1. A gain, examiner disagrees with

applicant's assertion because the combination of Hudetz et al and Powell does teach applicant's claimed invention. See argument regarding claim 1 above. Therefore, claim 4 remains rejected over Hudetz et al, Powell and Kaplan.

Conclusion

7. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed Romain Jeanty whose telephone number is (703) 308-9585. The examiner can normally be reached Monday-Thursday from 7:30 am to 6:00 pm.
If attempts to reach the examiner are not successful, the examiner's supervisor, Tariq R Hafiz can be reached at (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C 20231

or faxed to:

(703) 305-7687

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington VA, seventh floor receptionist.

February 19, 2003

RJ

TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600